

REMARKS/ARGUMENTS

This application has been carefully reviewed in view of the Final Office Action dated December 28, 2005. In that Office Action claims 1-87 were rejected. The claims of the present invention, as currently amended, are directed to a device that can detect both environmental hazards around a user and physical conditions of a user.

35 USC 102(e)

The Office Action rejected claims 1-3, 5-14, 23-33, 41-50, 56-61, 67-73, 75-83, and 85-87 under 35 USC §102(e) as being anticipated by Cho et al. (US 6,628,201). For a prior art reference to anticipate in terms of 35 USC §102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F2d 831, 15 USPQ 2d 1566 (Fed. Cir. 1990). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 927 F2 1565, 18 USPQ 2d 1001, 18 USPQ 2d 1896 (Fed. Cir. 1991).

Cho fails to disclose all of the elements of the claimed invention. Independent claims 1, 26, 44, 56, 67 and 79, as amended, each contain in the preamble either the phrase "physical and environmental conditions" or the phrase "physical condition and environmental hazard". The preamble requires that the claimed invention be capable of providing information about (or monitoring) both physical conditions **and** environmental hazards, whether simultaneously or separately. Cho does not teach detection of physical conditions. Thus, Applicants respectfully submit that the Cho reference does not anticipate claims 1-3, 5-14, 23-33, 41-50, 56-61, 67-73, 75-83, and 85-87 of the present application.

35 USC 103(a) - Claim 4

The Office Action also rejected claim 4 under 35 U.S.C. 103(a) as being unpatentable over Cho. The Office Action fails to identify where the prior art suggests the combination that is used to find claim 4 obvious. There must be

some suggestion or motivation in the prior art to combine references to support an obviousness rejection. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ.2d 1614, 1617 (Fed. Cir 1999) (the suggestion to combine prior art references must be “clear and particular.”); See also, *Ruiz v. A.B. Chance co.*, 234 F.3d 654 (Fed. Cir. 2000). In the instant Office Action, the suggestion or motivation to combine the references is not “clear and particular.”

The Office Action incorrectly relies upon the “notoriously old and well known patch” to apply to the teachings of Cho to find obviousness. This “notoriously old and well known” art is not sufficient to justify a finding of obviousness under the above standard. If the patch were “notoriously old and well known”, Cho would have included such in its disclosure. In fact, Cho teaches the use of a band or disc shape and away from a patch because a patch with skin contact is not required to detect environmental hazards. (Cho, col. 9, lines 12-17 and 27-34). A slave machine secured with an adhesive, as a patch, would not satisfy the aims of Cho since the slave machine could only be used a limited number of times, whereas a band or a disc could be used over and over again with different articles of clothing and different vehicles or buildings.

Since Cho clearly teaches away from the use of a patch, Applicants believe that the Office Action rejection used the Applicants’ invention as a guide in finding prior art to combine, thereby engaging in impermissible hindsight reconstruction. See, *W.L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1552-53, 220 USPQ 303, 312-13 (Fed. Cir. 1988). The Office Action has not taken into account “only knowledge which was within the level of ordinary skill at the time the claimed invention was made.” At the time, Cho taught against the use of the patch for its machines. It was not until the present invention that someone suggested a patch for environmental hazard detection.

In addition, as discussed above, because independent claim 1, as amended, is patentable over Cho, claim 4 which depends from claim 1 must also be patentable over the same art or in combination with other art. In addition, none of the other cited references teach the use of a patch. The

Office Action does not rely upon US Patent application Publication Number 2002/0156654 to Roe et al in combination with Cho for this rejection. Thus, Applicants respectfully submit that the cited prior art does not teach all of the limitations of claim 4.

35 USC 103(a) - Claims 15-22, 34-40, 51-55, 62-66, 74, and 84

The Office Action also rejected claims 15-22, 34-40, 51-55, 62-66, 74, and 84 under 35 U.S.C. 103(a) as being unpatentable over Cho in view of Cobb (US 5,771,001). The Office Action fails to identify where the prior art suggests the combination that is used to find the rejected claims obvious. Applicants believe that the Office Action rejection used the Applicants' invention as a guide in finding prior art to combine, thereby engaging in impermissible hindsight reconstruction. See, *W.L. Gore*, 721 F.2d at 1552-53, 220 USPQ at 312-13.

The independent claims, as amended, distinguish the present invention over both Cho and Cobb. A person having ordinary skill in the art would not look to Cobb when practicing the teachings of Cho. Where a person is seeking to detect environmental hazards around a user, that person would be motivated by different considerations than a person seeking to detect physical conditions of a user, i.e., air/radiation sensors versus temperature/blood pressure sensors.

In addition, the claimed invention detects physical conditions that are not taught by Cobb. Specifically, claims 17, 35, 51, 62, 74 and 84 each include as a limitation detecting a physical condition of a user including "blood pressure, heart rate, temperature, oxygen level, glucose level, skin condition, lipid levels, protein levels, carbohydrate levels, and genetic material". In contrast, Cobb only teaches detecting blood pressure, heart rate and temperature. Thus, Applicants respectfully submit that the cited prior art does render claims 15-22, 34-40, 51-55, 62-66, 74, and 84 obvious.

Conclusion

Accordingly, it is submitted that each of the pending claims 1-87 are in condition for allowance, notice of which is respectfully requested.

Respectfully submitted,

KELLY LOWRY & KELLEY, LLP

A handwritten signature in black ink, reading "Scott W. Kelley". The signature is written in a cursive style with a large, stylized "S" and "K".

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